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Filed: January 22, 2001  
Anton, et al.

### REMARKS

Claims 41- 60 are pending in the application. These claims stand rejected under 35 USC 103(a).

#### The Rejection Under 35 USC 103

The Examiner has rejected claims 41-60<sup>1</sup> as unpatentable over Castrogiovanni ('937), in view of Mercado ('044), Papantoniou ('105), Kumar ('477), Jack ('918)<sup>2</sup>, the International Cosmetic Ingredient Dictionary and Handbook, and Mausner ('441). The Examiner notes that Castrogiovanni teaches:

*A lipstick comprising a polymer, volatile oil, non-volatile oil, was employed herein and other ingredients well-known for lipstick, such as wax, isododecane, lanolin oil, dimethylsilicone, cyclomethicone, trioctyldodecyl citrate, etc.*

The Examiner further notes that *the lipstick may also containing [sic] polymethacrylate or polyacrylate* referencing column 3, lines 25-26.

The Examiner acknowledges that Castrogiovanni:

*Does not teach expressly the employment of the methacrylate polymers herein, or the vinyl pyrrolidone copolymers, or fluorinated oil.*

However, the Examiner notes that

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<sup>1</sup> While the Examiner's statement of the rejection is directed to claims 21-40, the Office Action Summary indicates that claims 41-60 are rejected. Claims 21-40 are no longer pending. Therefore it is assumed that the Examiner's rejection is applicable to pending claims 41-60.

<sup>2</sup> The Examiner's discussion of the rejection does not specifically refer to either Jacks ('918) or Mausner ('441). However, for the purposes of this response, it has been assumed that Jacks is cited for the disclosure relating to the use of copolymers of vinylpyrrolidone in lipsticks (OA, page 3) and that Mausner, while not specifically discussed, has a similar disclosure.

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*Papantoniou et al. teaches that polymethacrylate is known to be useful in lipstick composition for its film forming properties with other well-known ingredients such as silicone wax, lanolin oil etc.*

The Examiner urges that the reference teaches that *The employment of such polymer render the lipstick better quality than those without using polymer.*

The Examiner cites Mercado as teaching *expressly the usefulness of polyacrylate polymer in lipstick formulation*, noting column 3, lines 1-60 and example 18. The Examiner further states that *copolymers of vinylpyrrolidone are particularly known as film former in lipstick* noting the abstract, column 5, lines 66 bridging to column 6, line 10 as well as page 1179 of the International Cosmetic Ingredient Dictionary and Handbook.

The Examiner concludes that:

*it would have been prima facie obvious to a person of ordinary skill in the art at the time the claimed invention was made, to modify the lipstick composition of Castrogiovanni et al. by using the combination of acrylate polymer and vinylpyrrolidone copolymer.*

The Examiner urges that the modification of Castrogiovanni in this manner *because methyl methacrylate polymer and vinylpyrrolidone copolymers are known to be useful in lipstick compositions.*

The Examiner separately addresses claim 45, stating that the above discussed references, taken in further view of Kumar which is said to teach that isobornyl methacrylate is known to be similarly useful as methyl methacrylate as they polymerize to form polymers with similar glass transition temperature.

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The Examiner further urges that:

*it is prima facie obvious to combine two compositions each of which is taught in the prior art to be useful for [the] same purpose in order to form [a] third composition that is to be used for the very same purpose; [the] ideal to combining them flows logically from their having been individually taught in the prior art; thus the claimed invention which is a combination of two known film forming polymers known to be useful in lipstick sets for prima facie obvious subject matter.*

The applicants respectfully disagree with the Examiner's conclusion of the obviousness of the invention of claims 41 - 60.

The present invention of claims 41-60 are directed to a color cosmetic composition wherein the improvement over the prior art is that the composition additionally contains an uncrosslinked synthetic polymer made up of the polymerized monomers defined in claim 41 and a second shine enhancing homo-or copolymer having a refractive index of 1.5 or greater. (See claim 41). Examples of these types of synthetic polymers are methyl methacrylate (claim 44) and isobornyl methacrylate (claim 45). Examples of the second shine enhancing component, required by the claims, is polyvinylpyrrolidone, a copolymer of vinylpyrrolidone and one or more long chain alpha olefins, a copolymer of vinyl pyrrolidone and vinyl acetate, and a monoalkylester of polymethylvinyl ether/maleic acid (Claim 41). Thus, it is the inclusion of both of these defined ingredients which is the focus of the presently claimed invention.

As the Examiner has acknowledged, the primary reference, Castrogiovanni does not describe the use, in a lip stick composition, of either an uncrosslinked synthetic

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polymer having a glass transition temperature of 76 to 120° C, having the formula set forth in claim 41 or the second shine enhancing homo or co polymer with a reflective index of 1.5 or greater or the use of fluorinated oil (claim 57). While Castrogiovanni mentions polymethylmethacrylate beads, and acrylate polymers, this is with respect to the powder component of the described invention which is defined as dry, particulate matter having a particle size of 0.02-50 microns. This is neither suggestive of, or descriptive of, the currently claim required polymer. Further applicants contend that it does not suggest the general applicability or desirability of including a specific polymer material with a particular glass transition temperature into a color cosmetic composition as presently claimed. Further, there is nothing in Castrogiovanni which would be read by one of ordinary skill in this art to suggest that the particular ingredients required by the pending claims would be suitable for use with any product or type of product other than that which is explicitly described.

The Examiner has relied on Papantoniou as establishing that the use of polymethacrylate in this type of composition was known. However, Papantoniou does not describe the use of a second enhancing agent as specifically required by the present claims. No mention is found which would direct one of ordinary skill to incorporate into the compositions described a second enhancing agent having a refractive index of 1.5 or greater (Claim 41) such as a homo or copolymer of vinyl pyrrolidone (claim 49).

Further, Papantoniou does not mention or describe the use of fluorinated oils (claim 57). The Examiner has, additionally, relied on Mercado as teaching the usefulness of polyacrylate polymers in lipstick formulations. However, this component is defined at column 3, as being a copolymer having a molecular weight of 100,000 to about 1,000,000

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with the exemplified polymer material having a molecular weight of 100,000 to about 500,000. This compares to the present polymer material, which is described at page 4-6 as having a glass transition temperature of 76-120° C and preferably 80-115° and more preferably 90-110° C with an average molecular weight of 20,000. While the polymer of the invention may have a molecular weight of 5,000 to 300,000 it is preferably 5,000 to 50,000 and must have a glass transition temperature of 80 to 115° C. Mercado does not describe this particular polymeric material nor suggest its use in this type of cosmetic composition. Further, as with the previously discussed references, there is nothing to be found in Mercado which would reasonably be read to suggest or direct one of ordinary skill in this art to incorporate the required second shine enhancing agent which is a homo- or copolymer having a refractive index of 1.5 or greater.

The Examiner, apparently, has relied on Jack, Mausner, and page 1179 from the International Cosmetic Ingredient Dictionary and Handbook (hereinafter "CTFA Handbook") as describing the use of copolymers of vinylpyrrolidone as film formers in lipsticks. (OA, page 3). The applicants would initially note that the vinylpyrrolidone material of Jack is described as "high viscosity oil soluble liquids" (Emphasis added) (column 5, lines 66). Note for example the viscosities given for these materials at column 6, lines 1-2. As liquids, these materials would not be expected to exhibit the "glass transition temperature of 76-120° C" required of the present synthetic polymer material. Applicants would also note the definition of glass transition temperature appearing at page 4, lines 10-11 of the Specification which reasonably indicates that the polymeric materials required by the present claims are not liquids, but solids and thus differ materially from those described by Jack. As to Mausner, the disclosed lipstick

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composition is materially different from that of the present claims. The compositions of Mausner are powder based with no provision for an oil component as required by the claimed invention. Although Mausner makes of vinylpyrrolidone copolymer material, there is no other polymer material present which would correspond to that of the synthetic polymer of the present claims or any suggestion that the vinyl pyrrolidone copolymer described could be used in combination with other polymers, oils and particulate matter as required in claim 41. The page from the CTFA Handbook provides no more than is provided by Mausner to indicate that vinylpyrrolidone copolymers have been used in lipsticks. As regards the Examiner's reliance on the CTFA Handbook, 1997, Applicants draw the Examiner's attention to the "Declaration of Prior Invention in The United States or in a NAFTA or WTO Member Country to Overcome Cited Patent or Publication" submitted in conjunction with a prior amendment submitted having a certificate of mailing date of February 2, 2002. In this Declaration, Ann Ureneck states that she made a composition falling within the claims of the invention at least by December 5, 1995, which is well prior to the 1997 publication date on the CTFA Handbook. The CTFA Handbook excerpt provided by the Examiner has no specific date other than an indication it was published in 1997. However, assuming that it was published on January 1, 1997, this is still well after the date when Ann Ureneck reduced the invention to practice. Accordingly, the Examiner's reliance on the CTFA Handbook as prior art is not warranted.

Further, neither of the references mentioned would be read to teach the use of such a material, having a refractive index of 1.5 or greater in combination with the claim designated synthetic polymer having a glass transition temperature of 76 to 120° as

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required by claim 41. As to claim 45, the Examiner has additionally relied upon the teaching of Kumar to establish that isobornyl methacrylate "is known to be similarly useful as methyl methacrylate as they polymerize to form polymers with similar glass transition temperature." However, it is not readily apparent how the teaching of this reference relates to the use of isobornyl methacrylate in a cosmetic composition. Kumar describes the reaction of mercapto-functional silicone compound with a soft monomer and a hard monomer to arrive at a completely different polymer product. Among those materials described as suitable hard monomers is an isobornyl methacrylate and methacrylates. No mention is found of using these individual materials in a cosmetic composition as such. At best, this reference may suggest that these ingredients could be regarded as equivalent when used to produce silicone based polymeric materials having use in the cosmetic field. However, there is nothing that would suggest the use in either isobornyl methacrylate or methyl methacrylate, individually, in a cosmetic composition in the manner presently claimed.

A conclusion of obviousness premised on a combination of references must identify a reason, suggestion, or motivation that would have led an inventor to combine those references. Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629, (Fed. Cir. 1996)

It is insufficient that the prior art discloses the components of the claimed invention, either separately or in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by appellants. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (insufficient to select from the prior art the separate components of the inventor's

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combination, using the blueprint supplied by the inventor). Applicants would urge that there is no evidence or teaching in the reference relied on by the Examiner which would have reasonably suggested or directed one of ordinary skill to substitute or add both the claim designated synthetic polymer material having a glass transition temperature of 76 to 120 ° C and a second shine enhancing homo- or copolymer having a refractive index of 1.5 or greater to a color cosmetic composition comprising an oil component and a particulate matter component in a manner which would have resulted in the presently claimed invention. While it is possible that the Castrogiovanni could be modified in the manner proposed by the examiner, the fact that the reference could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In re Fritch, 972 F.2d 1260, 1266, n.14, 23 USPQ2d 1780, 1783-84, n.14 (Fed. Cir. 1982). On this record, there is no reason stemming from the prior art which would have led a person having ordinary skill to the claimed invention. The only reason or suggestion to combine the references in the manner proposed by the Examiner comes from Applicants' specification. However, use of that information would constitute impermissible hindsight in the construction of the rejection under 35 USC 103. In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Absent some teaching of this nature demonstrated to be present in the prior art, the combination of references, presently relied on by the Examiner, do not provide that level of evidence which would make the claimed subject matter obvious within the meaning of 35 USC 103(a).



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Thus, applicants would request that the Examiner reconsider the rejection of claims 41 - 60 under 35 USC 103 on this basis.

The Examiner is respectfully requested to reconsider the patentability of all claims pending in the application.

Respectfully Submitted,



Julie Blackburn  
Attorney for Applicants  
Reg. No. 32370  
Revlon Consumer Products Corporation  
625 Madison Avenue  
New York, New York 10022  
(212) 527-5531